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November 9, 2001

**VIA CERTIFIED MAIL: Restricted Delivery**

Dr. David A. Stenger  
CODE 6910  
Naval Research Laboratory  
Washington, D.C. 20375

Re: U.S. Patent Application for  
BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND  
PHARMACOLOGICAL SCREENING  
Serial Nos.: 09/880,138 and 09/928,708  
Inventors: James J. Hickman, Douglas G. Kirkpatrick  
and David A. Stenger  
Our Ref. No. 18805-81106 and 18805-81052

Dear Dr. Stenger:

It was a pleasure speaking with you regarding the above-identified patent application. As I mentioned during our telephone conference, I am one of the attorneys for Science Applications International Corporation ("SAIC") responsible for prosecuting the above-identified patent application.

During our telephone conference, you asked that we provide you with a copy of the application, after which you would make a determination as to whether you would execute the paperwork necessary to facilitate the prosecution of this application. Accordingly, we are enclosing a copy of the application, the Declaration, and the Assignment for your review.

Because of time constraints, we filed the application without an inventor(s)' Declaration and Assignment, (part of what is collectively known as "formal papers").

As we anticipate the *Notice of Missing Parts* from the United States Patent and Trademark Office ("USPTO"), we will need to file formal papers by no later than **November 20, 2001**. Therefore, we have prepared and enclose a copy of the application as filed, along with an original and one copy of an Inventor Declaration for each inventor's signatures. Of course, you will be signing on behalf of yourself. You will notice that there are two iterations of the

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Inventor(s) Declaration concerning this application. This is a result of the fact that this case has been pending for some time and the fact that the USPTO is processing the application in duplicate, giving rise to two application numbers assigned to the identical invention. As you can see, aside from the different application numbers, the two pending "Biosensor" applications are identical in all respects. At some point, the USPTO will elect to proceed with only one of them. Until that time, we have no choice but to prosecute both. If you have any questions regarding this matter, please do not hesitate to call me.

Although we have not independently confirmed your inventorship, we are operating under this understanding, in light of the fact that your name appears on the original application as one of the inventors. If you do not believe that you are one of the inventors, then please indicate to us as much in writing.

Please review the application for accuracy and completeness. It is essential to ensure that the application completely describes the best mode each inventor knows for carrying out the invention and to ensure that it is sufficiently detailed to teach one of ordinary skill in the art to make and use the invention. Also, you should read the claims carefully to ensure that they cover all known alternative embodiments of the invention and are not otherwise unduly limiting.

Please keep in mind that the Declaration contains an acknowledgment of the duty as an inventor to disclose all information of which each is aware that is material to examination of the application. This is a continuing duty which does not terminate upon filing of the application.

If it is believed that any changes are necessary in the disclosure or the claims, please let me know. For these changes, it may be possible to file a preliminary amendment before a first office action by the USPTO.

Once you have reviewed the application and confirmed that it complies with the foregoing, please refer to page 3 of each Declaration, fill in your complete residence address (a USPTO requirement), verify your citizenship, then sign and date the Declaration. If any of the information provided must be corrected, then please white-out the incorrect information and type-in the correct information.

Also enclosed is an original and one copy of an Assignment of the invention. Please complete your residence address on the first page of the original Assignment, sign and date as indicated using the same date as the patent Declaration and have your signature notarized. Please return the executed originals of the Declaration and notarized Assignment to us in the pre-paid, self-addressed FedEx envelope enclosed for your convenience.

As I am sure you can appreciate, the application is highly confidential and neither it nor the information embodied therein may be disclosed to third parties.

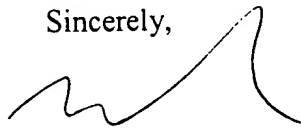
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We look forward to your prompt response as we are operating on a short deadline in which to file these papers with the USPTO.

In addition, as we have to date been unable to locate Dr. Douglas Kirkpatrick's whereabouts, we would appreciate your providing us with contact information for him, if you know. He also is required to execute these materials.

We thank you in advance for your anticipated cooperation in this matter.

Sincerely,

A handwritten signature in black ink, appearing to read 'Mark B. Mizrahi', with a stylized, flowing script.

Mark B. Mizrahi

MBM:shd

Enclosures:

- Copy of the applications, with Preliminary Amendment
- Original and one copy of Declarations
- Original and one copy of Assignment
- Pre-paid, self-addressed FedEx envelope

**APPLICATION**  
**for**  
**UNITED STATES LETTERS PATENT**

**on**  
**BIOSENSOR FOR USE IN TOXICITY ASSESSMENT**  
**AND PHARMACOLOGICAL SCREENING**

**by**  
**JAMES J. HICKMAN, DOUGLAS G. KIRKPATRICK, AND DAVID A. STENGER**

18810-81106  
Sheets of Drawings: 5

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Docket No.  
18805-81106



## Declaration For Patent Application

### English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND PHARMACOLOGICAL SCREENING**

the specification of which

(check one)

☐ is attached hereto.

☒ was filed on JUNE 12, 2001 as United States Application No. or PCT International

Application Number 09/880,138

and was amended on n/a

(if applicable)

RECEIVED  
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OFFICE OF PETITIONS

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Not Claimed

n/a

(Number)

n/a

(Country)

n/a

(Day/Month/Year Filed)

☐

☐

☐

(Number)

(Country)

(Day/Month/Year Filed)

(Number)

(Country)

(Day/Month/Year Filed)



Full name of sole or first inventor <b>JAMES J. HICKMAN</b>	
Sole or first inventor's signature	Date
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Post Office Address <b>Same as above</b>	

Full name of second inventor, if any <b>DOUGLAS A. KIRKPATRICK</b>	
Second inventor's signature	Date
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Citizenship <b>U.S.A.</b>	
Post Office Address <b>Same as above</b>	

Full name of third inventor, if any <b>DAVID A. STENGER</b>	
Third inventor's signature	Date
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Citizenship <b>U.S.A.</b>	
Post Office Address <b>Same as above</b>	

Full name of fourth inventor, if any	
Fourth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	

Full name of fifth inventor, if any	
Fifth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	

Full name of sixth inventor, if any	
Sixth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	

Full name of seventh inventor, if any	
Seventh inventor's signature	Date
Residence	
Citizenship	
Post Office Address	

Full name of eighth inventor, if	
Eighth inventor's signature	Date
Residence	
Citizenship	
Post Office Address	



**EXHIBIT A**

Patent application Serial No. 09/880,138, filed on June 12, 2001, was filed in connection with Applicant's Petition to Revive filed on that same date. If the petition is granted, the 09/880,138 application will be accepted as a continuation of Serial No. 09/513,720, filed on February 24, 2000, and which unintentionally went abandoned on June 12, 2000. In the event that the Petition is not granted, the 09/880,138 application will be deemed related to the 09/513,720, rather than a continuation thereof.

The 09/513,720 application was itself a continuation of application Serial No. 09/372,568 filed on August 11, 1999, the prosecution of which was abandoned in favor of the 09/513,720 application.

Patent application Serial No. 09/372,568, in turn, was a continuation of application Serial No. 09/236,684, filed on January 25, 1999, the prosecution of which was abandoned in favor of the 09/372,568 application.

Patent application Serial No. 09/236,684, in turn, was a continuation of application Serial No. 09/109,481, filed on July 2, 1998, the prosecution of which was abandoned in favor of the 09/236,684 application.

Patent application Serial No. 09/109,481, in turn, was a continuation of application Serial No. 08/912,033, a non-provisional utility application, filed on August 15, 1997, the prosecution of which was abandoned in favor of the 09/109,481 application.

Patent application Serial No. 08/912,033, in turn, claims the benefit of provisional application Serial No. 60/023,413, filed on August 16, 1996.